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20 JUN 2007

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In re Application of	:	DECISION ON
Joseph E. FITZGERALD et al	:	
PCT No.: PCT/US2004/039658	:	
Application No: 10/578,091	:	
Int. Filing Date: 24 November 2004	:	PETITION UNDER
Priority Date: 26 November 2003	:	
Attorney's Docket No.: 200406552-4	:	
For: SYSTEM AND MEHTOD ...	:	
IMAGES FOR COMPUTERS	:	37 CFR 1.47(a)

This is in response to the "Communication" filed on 02 April 2007, which is being treated as a petition under 37 CFR 1.47(a). The \$200.00 petition fee has not been provided.

**BACKGROUND**

On 24 November 2004, applicants filed international application PCT/US2004/039658, which claimed priority to an earlier application filed 26 November 2003. The thirty (30) month time period for paying the basic national fee in the United States of America expired at midnight on 26 May 2006.

On 03 May 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee. However, no executed declaration or oath was submitted at such time.

On 04 January 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating, *inter alia*, that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date, and that it was not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68." "The notification set two (2) months from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicants, inter alia, filed on 02 April 2007, a petition under 37 CFR 1.47(a), and an executed declaration was filed without the signature of inventor Edward Kahn. Also, included were a declaration of Edward J. Brooks, and an affidavit of Tuan V. Ngo indicating that Me. Edward Kahn refuses to sign the declaration.

## **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

### **REFUSAL TO JOIN:**

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has not satisfied items (1) – (4) of 37 CFR 1.47(a).

Regarding item (1), petitioner has been not provided the petition fee \$200 under 37 CFR 1.17(g).

Regarding item (2), although the statement by Mr. Brooks states that he has sent three letters to him and Mr. Kahn. However, it has not been sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor. It is unclear what documents were forwarded to Mr. Kahn because Mr. Brooks refers only refers to the declaration and there is no statement referring to a copy of the application papers (specification, including claims, drawings, and oath or declaration) as required under MPEP. 409.03(d) being sent to him.

Regarding item (3), petitioner has provided an affirmative statement of the last known address of the nosigning inventor.

Regarding item (4), petitioner has provided a defective declaration because there are alterations on it - lines across the information on it (note the section under Phil Burgard with his signature). Any alternation made after the signing of an oath or declaration must be supported by a supplemental oath or declaration under §1.67. Note 37 CFR §1.52.

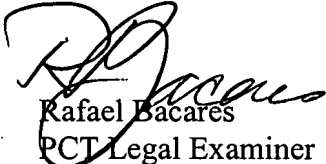
Consequently, the petition has not met the requirements under 37 CFR 1.47(a).

### **DECISION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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